

REMARKS

This paper is submitted in reply to the Office Action dated January 4, 2006, within the three-month period for response. Reconsideration and allowance of all pending claims are respectfully requested.

In the subject Office Action, the specification was objected to for containing embedded hyperlinks and/or other forms of browser-executable code. Furthermore, claims 31-32 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In addition, claims 1-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2004/0172415 to Messina et al.

Applicants respectfully traverse the Examiner's rejections to the extent that they are maintained. Applicants have canceled claim 32 without prejudice and amended claim 31. Applicants respectfully submit that no new matter is being added by the above amendments, as the amendments are fully supported in the specification, drawings and claims as originally filed.

Now turning to the subject Office Action, and specifically to the objection to the specification, the Examiner will note that the links in the specification at pages 5, lines 26 and 28, and 21, lines 16 and 21, are not active links, but rather are merely examples of suitable advertisements (indeed, neither link references a real web site). Therefore, these links are not objectionable pursuant to MPEP § 608.01.VII.¹ Applicants therefore respectfully submit that the specification is proper, and withdrawal of the objection is respectfully requested.

Next, with respect to the §101 rejection, the Examiner will note that claim 31 has been amended to recite a "computer readable medium" as per the Examiner's suggestion. Furthermore, claim 32 has been canceled, and accordingly, reconsideration and withdrawal of the Examiner's §101 rejection are respectfully requested.

¹ "Where the hyperlinks and/or other forms of browser-executable codes themselves rather than the contents of the site to which the hyperlinks are directed are part of applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. 112, first paragraph, and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks."

Now turning to the art-based rejections, and specifically to the rejection of independent claim 1, this claim generally recites a computer-implemented method of advertising. The method includes searching a plurality of electronic messages associated with at least one electronic community to locate a first electronic message that includes a query directed to a topic of interest, and subsequent to locating the first electronic message, sending a second electronic message that includes a reply to the query and an advertisement related to the topic of interest to which the query is directed.

In rejecting claim 1, the Examiner relies on Messina, and while no specific passages are cited, Applicants note that paragraphs [0059] and [0075] were the only passages in the reference that Applicants could find that are even arguably related to advertising. Messina, in general, is directed to a tool for automating the posting and retrieval of content in on-line communities. The three primary functions described are that of automating the posting of messages to multiple communities, automating the collection of replies to those messages from the various communities, and automating searching of multiple communities according to a search or fitness criteria (abstract).

Paragraph [0059] describes an application of the Messina system whereby corporations may post advertisements or product testimonials to solicit public response, as well as an application whereby classified advertisements may be posted to multiple forums. In both instances, the advertisements are original posts, and there is no disclosure that these posts are replies to other posts. As such, this paragraph is irrelevant to the subject matter of claim 1.

Paragraph [0075] deals with recruiting members to participate in the building of a theme-oriented database or community. In particular, Fig. 5 and paragraphs [0062]-[0066] disclose how a community may be constructed by bringing together information sources, experts and other members related to a particular topic or theme. Fig. 6 and paragraphs [0067]-[0094] describe a flowchart for building such a community, and in this regard, one series of steps in doing so includes identifying, evaluating, and recruiting a set of "candidate" members, which may be web sites and/or individuals related to a particular topic or theme. Paragraph [0074] specifically discusses recruiting or inviting individuals

to join the community, in connection with block 602.4 of Fig. 6. Discussed is the option of sending emails or other solicitations to candidates to encourage them to join the community, which solicitations may include promises of financial incentives.

Paragraph [0075] then goes on to discuss the use of a crawler module to post messages to encourage individuals to join the community. The paragraph further states:

[i]n some cases, the messages includes hyperlinks or URLs to the site and some incentive for visiting the website, such as an electronic coupon or gift certificate or bonus access rights to otherwise inaccessible content on the site. Some embodiments even reply directly to specific retrieved postings with such messages. An exemplary message might state that based on the content of your post, you would be interested in the one or more of the following websites, on-line forums, newsgroups, etc.

Of note, this paragraph implies that Messina is capable of searching the content of a post and replying with an invitation to visit the theme-based community. Therefore, at the most, Messina suggests that the content of a message may be searched and that, based upon the content, a reply may be generated with an advertisement that is related to the searched content.

Messina, however, does not disclose or suggest specifically searching for a first message that includes a query directed to a topic of interest, coupled with sending a second message that includes a reply to the query along with an advertisement related to the topic of interest, as required by claim 1.

Indeed, the Examiner admits that Messina does not disclose an original message containing a query. What Messina also fails to disclose or suggest, however, is that a second message may be generated with a specific reply to that query.

The Examiner attempts to address this shortcoming in Messina by relying on Applicants' discussion of query detection algorithms at page 16 of the Application. However, even if query detection algorithms are known in the art, the Examiner has still failed to establish a *prima facie* case of obviousness as to claim 1.

First, even if the Examiner could establish a motivation in the art to modify Messina to incorporate a query detection algorithm to search specifically for messages that contain queries, claim 1 additionally requires that a second message be sent including a "reply to the query" along with an advertisement related to the topic of interest of the query. Of note, claim 1 does not simply refer to generating a reply to the first message – the reply is "to the query" included within the first message. Paragraph [0075] of Messina merely notes that "[a]n exemplary message might state that based on the content of your post, you would be interested in the one or more of the following websites, on-line forums, newsgroups, etc.," and there is no suggestion in the reference that the exemplary message might include a specific reply to the query posed in the message being responded to. As such, even the incorporation of a query detection algorithm into the Messina system would fall short of disclosing or suggesting each and every feature of claim 1.

Second, Applicants respectfully submit that the Examiner would necessarily be required to rely on hindsight to modify Messina in the proposed manner. A *prima facie* case of obviousness cannot rely on Applicants' specification to provide motivation to modify. In particular, a *prima facie* showing of obviousness requires objective evidence of the suggestion, teaching or motivation to combine or modify prior art references, as "[c]ombining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." In re Dembieczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)."

In this instance, the Examiner relies solely on Applicants' disclosure for the supposed known status of query detection algorithms to provide evidence of a motivation to modify Messina. There is no such suggestion in Messina, and no other objective evidence, outside of Applicants' disclosure, has been proffered by the Examiner to support the contention that one of ordinary skill in the art would have been motivated to modify Messina to specifically search for queries in messages and to generate messages containing replies to any found queries.

Indeed, the Examiner's argument for modifying Messina, found at page 3 of the Office Action states that:

[i]t would have been obvious to one having ordinary skill . . . to restrict Messina's crawler module to reply to only queries using a well-known query detection algorithm to augment the crawler's logic. This would better target a message-board user as one who is seeking advice, so that user might not frown upon an advertisement as a reply. (*emphasis added*).

Of note, the statement underlined above is practically taken directly from Applicants' disclosure, e.g., at p. 5, lines 10-18, which further supports Applicants' position that the only suggestion to modify Messina in the proposed manner comes from Applicants' disclosure, and as such, would necessitate the use of hindsight.

Absent reliance on Applicants' disclosure, there is no objective evidence of a suggestion in the art to modify Messina to specifically search for messages with queries, or to generate other messages that incorporate replies to those queries along with related advertisements. Accordingly, no *prima facie* case of obviousness exists with respect to claim 1.

Applicants therefore submit that independent claim 1 is novel and non-obvious over the Messina et al. Reconsideration and allowance of independent claim 1, as well as of claims 2-16 that depend therefrom, are therefore respectfully requested.

Next with regard to independent claims 17 and 31, each of these claims recites in part program code configured to search a plurality of electronic messages associated with at least one electronic community to locate a first electronic message that includes a query directed to a topic of interest, and, subsequent to locating the first electronic message, send a second electronic message that includes a reply to the query and an advertisement related to the topic of interest to which the query is directed. Accordingly, claims 17 and 31 are novel and non-obvious over the prior art of record for the same reasons as presented above for claim 1. Reconsideration and allowance of independent

claims 17 and 31, as well as of claims 18-30 that depend therefrom, are therefore respectfully requested.

Next, with respect to the various dependent claims currently pending in the instant Application, Applicants traverse the Examiner's rejections based upon the dependency of these claims upon their respective independent claims. Furthermore, Applicants note that a number of these claims recite additional subject matter that is not disclosed or suggested by the prior art of record. In addition, with respect to a number of these claims, it is quite evident that hindsight is being relied upon in formulating the rejections, as there is no suggestion in the prior art of record to modify Messina to incorporate the additional features recited in these claims.

For example, claims 8 and 23 recite that the reply included in the second message includes "an answer to the query." The Examiner asserts at p. 3 of the Office Action that "[a]ny reply (Messina's replies identify information sources) to a query is taken to be an answer to that query." The Examiner's argument in this regard, is deficient in several respects.

First, Messina discloses only replies to messages, not replies to queries included in messages. The distinction between replying to a message, versus replying to a query in a message, has been discussed above in connection with claim 1. As a further example, it is generally known that communities such as mailing lists typically permit anyone to reply to any message with little or no control over the content of the reply message, and as such, it would be possible for one member of a mailing list to reply to a message posted by another member, with that reply message including an advertisement. While such a reply message would likely constitute a reply to the earlier message, the reply message would not be a reply to a query included in the earlier message.

Second, Applicants have clearly distinguished the concept of an "answer" from a "reply," and as such, the Examiner's assertion that any reply constitutes an answer improperly reads the concept of an answer out of claims 8 and 23. Through the doctrine of claim differentiation, claims 8 and 23, which specify that a reply includes an answer to a query, are necessarily more specific than claims 1 and 17, so it is improper for the

Examiner to discount answers as being synonymous with replies. Also, Applicants discuss two primary variations on a "reply to a query" throughout the disclosure, e.g., at p. 5, lines 19-30 and p. 21, lines 6-23. The first variation is to provide as the reply a suitable answer to the question posed by the query. The second variation is to provide as the reply information on how to retrieve a suitable answer from another source. Therefore, it is evident that an answer is not synonymous with a reply, contrary to the Examiner's assertion. An answer, within the context of claims 8 and 23, is required to provide a suitable solution to the question posed by a query within the second message. Neither Messina, nor any other art of record, suggests the incorporation of an answer to a query as a reply. In fact, the only example provided in paragraph [0075] of Messina is a reply message that directs a reader to the on-line community if they have an interest in the topic of the on-line community. Even disregarding the fact that the reply message does not provide a reply to any query, there is nothing in the reply message that is analogous to an answer to a particular query.

Applicants therefore respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness as to claims 8 and 23. Reconsideration and allowance of these claims are respectfully requested.

As another example, claims 14 and 28 recite the additional concept of determining whether a query is capable of being answered, such that the second message is sent only if it is determined that the query is capable of being answered. In rejecting this claim, the Examiner asserts on page 4 of the Office Action that it is inherent that a message posted on an electronic community can be responded to. Applicants submit this position is entirely reliant on hindsight, however, as there is no suggestion in Messina, or the other prior art of record, to condition whether a message is generated based upon whether a query that has been located in another message is determined to be capable of being answered.

In fact, there is no suggestion of the desirability of even making such a determination in the first place. The Examiner relies on the supposed conventionality of query detection algorithms, but even if such algorithms were known, they would teach, at

the most, the fact that a query can be detected in a message. The algorithms, by themselves, would not suggest the additional step of, once a query is detected, making a determination as to whether the query is capable of being answered. There is also no suggestion from these algorithms to condition the generation of a second message based upon whether a query is capable of being answered. Messina quite evidently does not provide any such suggestion, and as such, one of ordinary skill in the art would not be motivated to modify Messina as suggested by the Examiner.

Furthermore, Applicants wish to note again that the determination recited in claims 14 and 28 is whether a query is capable of being answered, and not whether a message (even a message including a query) is capable of being answered. The Examiner's arguments improperly assume the latter, as the Examiner's position as to the "inherency" of responding to a message does not even address the concept of responding to a query in a message.

Applicants therefore respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness as to claims 14 and 28. Reconsideration and allowance of these claims are respectfully requested.

As yet another example, claims 15 and 29 recite the additional concept of determining whether the query has already been answered, such that the second message is sent only if it is determined that the query has not yet been answered. In rejecting this claim, the Examiner acknowledges on page 4 of the Office Action that Messina does not disclose this feature, but asserts that it would have been obvious to not answer the same post twice. Applicants submit this position is entirely reliant on hindsight, however, as there is no suggestion in Messina, or the other prior art of record, to condition whether a message is generated based upon whether a query that has been located in another message is determined to have already been answered, or even to make such a determination in the first place. The Examiner's assertion of a motivation lacks any evidentiary support whatsoever, and accordingly, improperly relies on hindsight.

Applicants therefore respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness as to claims 15 and 29. Reconsideration and allowance of these claims are respectfully requested.

In summary, Applicants respectfully submit that all pending claims are novel and non-obvious over the prior art of record. Reconsideration and allowance of all pending claims are therefore respectfully requested. If the Examiner has any questions regarding the foregoing, or which might otherwise further this case onto allowance, the Examiner may contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

April 4, 2006
Date

/Scott A. Stinebruner/
Scott A. Stinebruner
Reg. No. 38,323
WOOD, HERRON & EVANS, L.L.P.
2700 Carew Tower
441 Vine Street
Cincinnati, Ohio 45202
Telephone: (513) 241-2324
Facsimile: (513) 241-6234